

REMARKS

The Official Action mailed August 19, 2008, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Two Month Extension of Time*, which extends the shortened statutory period for response to January 19, 2009. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on July 27, 2006, and September 21, 2006.

Claims 1-26 are pending in the present application, of which claims 1-4, 8, 9, 13-16, 20 and 21 are independent. Dependent claim 10 has been canceled without prejudice or disclaimer, independent claims 1-4, 8, 9, 13, 15, 16, 20 and 21 have been amended to better recite the features of the present invention, and dependent claims 5 and 17-19 have been amended to correct a minor informality. Accordingly, claims 1-9 and 11-26 are now pending in the present application, of which claims 1-4, 8, 9, 13-16, 20 and 21 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1, 3, 4, 6-9, 13, 15, 16, 18-21 25 and 26 as anticipated by U.S. Publication No. 2003/0218418 to Sato. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 1-4, 8 and 9 have been amended to recite a composite material comprising an inorganic compound that is an oxide of a transition metal. Independent claims 13, 15, 16, 20 and 21 have been amended to recite a light emitting element comprising an inorganic compound that is an oxide of a transition metal. The Applicant respectfully submits that Sato does not teach the above-referenced features of the present invention, either explicitly or inherently. Since Sato does not teach all the

elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 5 of the Official Action rejects claims 2, 5, 10-12, 14, 17 and 22-24 as obvious based on the combination of Sato and U.S. Patent No. 6,084,176 to Shiratsuchi. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Sato. Shiratsuchi does not cure the deficiencies in Sato. The Official Action concedes that Sato "does not explicitly disclose ... carbazole compounds with a metal oxide in the hole transporting layer" (page 5, Paper No. 20080813). However, Shiratsuchi does not cure the deficiencies in Sato. Shiratsuchi also does not teach or suggest carbazole compounds with a metal oxide in the hole transporting layer. Therefore, Sato and

Shiratsuchi, either alone or in combination, do not teach or suggest carbazole compounds with a metal oxide in a hole transporting layer.

Since Sato and Shiratsuchi do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore, there is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Sato and Shiratsuchi or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

Sato appears to relate to an organic electroluminescent device. However, Shiratsuchi appears to relate to a solar cell. The Official Action has not demonstrated why one of ordinary skill in the art at the time of the present invention would have had a reason to apply the teachings of a solar cell to an organic electroluminescent device in order to achieve the features of the present invention.


Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Sato and Shiratsuchi or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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